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In re Application of David G. Wang. :
Serial No. : 09/925,065 : PETITION DECISION
Filed : 08-08-2001 :
Attorney Ref No. : 108827.135 :

This letter is in response to the Petition under 37 C.F.R. 1.144, filed on June 20, 2005, to request the review and withdraw of the restriction requirement. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed on August 8, 2001 claiming the benefit of several provisional applications.

On July 1, 2004, Examiner mailed a restriction requirement designating inventions corresponding to Groups 1-960028 comprising Claim 1, drawn to SNP probes, classified in class 536, subclass 24.32. Examiner argued that each individual group relates to one of SEQ ID NO starting from SEQ ID NO: 375636-1335663 as recited in claim 1. Examiner noted that the inventions are unrelated because the different inventions are drawn to unique nucleic acid molecules which are distinct in structure and function. Examiner argued that each sequence is patentably distinct because they are unrelated sequences, i.e. the protein encoded by these sequences differ in structure and in function and in biological activity. Examiner also stated that even where the nucleic acid changes have no effect on protein structure or function, these sequences themselves represent allelic variations which have different diagnostic and therapeutic implications and that the search and examination of each individual single nucleotide polymorphism probe is separate requiring separate nucleic acid sequence searches and separate searches in the patent and non-patent prior art which would pose an enormous burden on PTO and examiner search resources.

On October 4, 2004, in response to the Restriction Requirement, applicant elected, with traverse, the sequence of SEQ ID NO: 375,636 (which was amended herein to be SEQ ID NO: 1). Applicant respectfully averred that because all of the sequences have been provided in

electronic format to the Patent Office, a search of all of these sequences is not unduly burdensome and requested that all of the sequences be examined together. In addition, applicant also indicated plans to file a request to convert this application to a Statutory Invention Registration (SIR) once the Sequence Listing is published. Applicant also noted that the request for an SIR will not be filed until after the Sequence Listing is published, to ensure that all of sequences are, in fact, published, and that the sequences are correct.

In response to the election, the examiner acknowledged the election of Group I, i.e., SEQ ID NO: 1, found the traversal non-persuasive and made the restriction requirement FINAL, in the paper mailed February 18, 2005. A first office action on the merits was also mailed as a part of this same communication, in which claim 1 was rejected under 35 USC 102(b), as well as under 35 USC 103(a).

In response to the Office action of February 18, 2005, applicants filed the instant petition, along with a proper request for SIR on June 22, 2005.

DISCUSSION

The application, file history and petition under 37 C.F.R. 1.144, to request review of the restriction requirement and the request for SIR has been considered.

Applicants have filed a proper request for SIR. There are no outstanding rejections under 35 U.S.C. 112, 1st or 2nd paragraphs as required by SIR. Upon granting of SIR status, prosecution on the merits is otherwise terminated. Thus any decision as to the correctness of the restriction requirement would be moot in view of the termination of prosecution.

DECISION

For these reasons, the petition under 37 C.F.R. 1.144, to request to withdraw the restriction is **DISMISSED**.

Any request for consideration must be filed within two (2) months of the mailing date of this decision.

The application will be forwarded of processing as a SIR.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-273-8300.

A handwritten signature in cursive script that reads "Jasmine C. Chambers".

Jasmine Chambers
Director, Technology Center 1600